

Remarks

The Official Action dated December 27, 2004 has been carefully considered. Consideration of the changes and remarks presented herein and reconsideration of the rejections are respectfully requested.

Claims 1-31 remain in the present application. Claims 1 and 16 have been amended for clarification of language in the original claim. Support for the amendments can be found in the specification, claims and drawings as originally filed such as at, for example, page 3, line 21 to page 7, line 24. Accordingly, it is believed that these changes do not involve any introduction of new matter, and entry is believed to be in order and is respectfully requested.

The Office Action cites to Carrigan, III as being US Patent 6,546,177. However, this reference was not cited in Applicants' information disclosure statement or on the PTO-Form 892 that accompanied the Office Action, and it appears that this citation is referring to US Patent 6,565,177 issued to Corrigan, III. Accordingly, Applicants request that an additional PTO-Form 892 be provided in the next action indicating that this reference was considered.

Claim Rejections

In the Office Action, claims 1, 10, 14, 16, 25 and 29-31 were rejected under the argument that they are unpatentable over Corrigan, III in view of Conta (US 6,371,589), and claims 2-9, 11-13, 15, 17-24, and 26-28 were rejected under the argument that they are unpatentable over Corrigan III in view of Conta et al., in further view of Tanaka et al. (US 2002/0060333), Aswell (US 2001/0050410), and the Stanley Wolf reference.

Applicants respectfully traverse the rejections. A §103 rejection is not proper unless the combination of references, even assuming arguendo that they could be combined in the manner claimed, teach or suggest all of the claim elements. MPEP § 2143. In the present case, not all

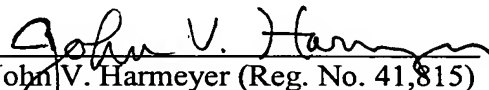
elements of the claims are shown by the cited references, even when considered in the argued combination. For example, contrary to the arguments in the office action, Conta does not appear to include any disclosure of implantation of a temperature sense resistor. Rather, the reference explicitly states 1) that the emission resistor is arranged on a substrate, 2) that the print head includes a protective layer arranged on the emission resistor, a layer of Ta arranged on the protective layer and a layer of electrically conductive material arranged on the layer of Ta, and 3) *that the temperature sensor is formed from the layer of electrically conductive material*. This is indicated in the reference in, for example, Column 9, lines 46-57 and the Abstract, as well as in Col. 6, line 43- Col 7, line 10 of the reference which again indicates that temperature sensors are deposited on the layer of Ta 19. Thus, the Conta reference does not appear to teach or suggest the implantation of a temperature sense resistor, and Applicants did not find the portion of Column 2 of the reference, cited in the Office Action, as being related to the formation of the temperature sense resistor. Accordingly, the Corrigan III and Conta et al. references, even assuming arguendo they could be combined, would not show all of the elements of the claims, for at least these reasons. Applicants did not find this feature to be in the other references cited in the rejections, nor were those references cited for that purpose.

Furthermore, even if prior art could be combined to result in a claimed invention, the combination would not render a claim obvious unless the prior art suggests the desirability of the combination. In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this case, there is no showing of a motivation or suggestion for making the argued combination of references. Even if prior art were capable of being combined or modified to operate as in the claimed invention, there must be some suggestion or motivation in the references to do so. MPEP § 2143.01.

For at least the above reasons, it is respectfully submitted that the cited references fail to teach all of the elements of the claims, for at least these reasons. Accordingly, it is respectfully requested that the rejections be reconsidered and withdrawn

It is believed that the above represents a complete response to the rejections and that the present application is in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,


John V. Harmeyer (Reg. No. 41,815)
DINSMORE & SHOHL LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202
(513) 977-8649